

REMARKS

Amendments to the Specification

The specification was amended to correct the statement regarding federally sponsored research; in particular, the grant number for NIH was added. No new matter has been added with this amendment.

The specification was also amended to update the priority claim. In particular, the claim was amended to state that the 09/996,420 application claims priority from U.S. provisional application 60/250,202, which was filed November 30, 2000.

Status of the Claims

Claims 53-61 are as previously presented. Claim 52 is currently amended to recite the specific bacteria. Support for this amendment can be found at page 3, lines 26-27, and at page 83 of the specification as filed.

With these amendments, claims 52-61 are pending.

Priority

Concurrently with this response, Applicants submit a Petition to Accept Unintentionally Delayed Priority Claim pursuant to 37 C.F.R. § 1.78(a)(6), which claims the benefit to U.S. provisional application 60/250,202 filed November 30, 2000.

Rejections under 35 U.S.C. § 112, first paragraph

Claims 52-61 stand rejected under 35 U.S.C. § 112, first paragraph, “because the specification, while being enabling for treating specific condition of DNA methyltransferase mediate, bacterium induced disease (*i.e.*, otitis media)... does not reasonably provide enablement for ‘treating DNA methyltransferase mediate, bacterium induced disease’...” Applicants respectfully disagree. However, in order to expedite the prosecution, the claims were amended to recite the specific disease inducing bacteria. Applicants respectfully submit that the amended claims are fully enabled by the specification and that no undue experimentation is needed to practice the art. Consequently, reconsideration and withdrawal of the rejection of claims 52-61 under 35 U.S.C. § 112, first paragraph, is respectfully requested.

Rejections under 35 U.S.C. § 102(e)

The Office maintained the rejection of claims 52-61 under 35 U.S.C. § 102(e) as allegedly being anticipated by Lee *et al.* (U.S. Pub. 20050054644) or Benkovic *et al.* (U.S. Pub. 20040259833) because the priority claim was not perfected. Applicants respectfully request reconsideration and withdrawal of this rejection in view of the Petition to Accept Unintentionally Delayed Priority Claim pursuant to 37 C.F.R. § 1.78(a)(6), which Applicants submit herewith. Applicants further note that the instant application claims priority from the Benkovic *et al.* publication and as such, the rejection of the instant claims based on this reference should be withdrawn.

Rejections under 35 U.S.C. § 103(a)

The Office maintained the rejection of claims 52-61 under 35 U.S.C. § 103(a) as being unpatentable over Patel *et al.* (U.S. Pat. No. 5348947) in view of Vermeulen *et al.* (U.S. Pat. No. 5872104), Barney *et al.* (U.S. Pat. No. 6068973), and Lonetto *et al.* (U.S. Pat. No. 6165762) because the priority claim was not perfected. Applicants respectfully request reconsideration and withdrawal of this rejection in view of the Petition to Accept Unintentionally Delayed Priority Claim pursuant to 37 C.F.R. § 1.78(a)(6) submitted herewith.

Double Patenting Rejection

Claims 52-61 are rejected on the ground of non-statutory obviousness-type double patenting over claims 19-23 of U.S. Patent No. 7465836. Applicants respectfully disagree.

The '836 patent claims the method of treatment using the compounds of claim 1, which are 1-phenyl-1,3-dihydrobenzo[c][1,2]oxaborole derivatives. This is different from the currently claimed compounds, which are diaryl-substituted borinic acid esters. In addition, all these esters are ethanolamine derivatives. Therefore, the subject matter of claims 52-61 is not suggested, taught or rendered obvious by the '836 patent's claims. Thus, reconsideration and withdrawal of this rejection is respectfully requested.

CONCLUSION

Entry of the claim amendments, allowance of the claims and passage of the case to issue are respectfully solicited.

The Applicants urge the Examiner to contact the Applicants' undersigned representative at (312) 913-2114, if the Examiner believes that a discussion would expedite prosecution of this application.

Respectfully submitted,

Dated: October 1, 2009

By: /Bradley W. Crawford/
Bradley W. Crawford
Reg. No. 50,494

Telephone: 312-913-0001 (general)
Facsimile: 312-913-0002

**McDonnell Boehnen
Hulbert & Berghoff LLP**
300 South Wacker Drive
Chicago, IL 60606